United States Court of Appeals

for the Second Circuit

APPELLANT'S REPLY BRIEF

75-7152

To be argued by
WALTER HOFER

In The

United States Court of Appeals

For The Second Circuit

MARION ROSETTE,

Plaintiff-Appellee,

vs.

RAINBO RECORD MANUFACTURING CORPORATION and HAROLD E. MARKOWITZ AND JACK BROWN, doing business as RAINBO RECORD COMPANY, a partnership,

Defendants-Appellants.

On Appeal from the United States District Court for the Southern District of New York

REPLY BRIEF FOR DEFENDANTS-APPELLANTS

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REPLY BRIEF FOR APPELLANT

RESTATEMENT OF THE ISSUES PRESENTED

Although "publication" is nowhere precisely defined in the Copyright Act, the concept of publication has been characterized as the heart of our present copyright system. When publication occurs, the author is divested of the common law rights reserved to him in section 2 of the Copyright Act and is invested with statutory copyright rights and privileges.

Judge Gurfein discounted much previous dicta in ruling that a phonograph record is not a copy of a musical composition and thus sale of the record does not constitute publication of the underlying composition.

This left open the following questions to which the plaintiff-appellee directs her cross-appeal:

> "Can the States, by virtue of the common law, constitutionally impose a lesser requirement when copyright has been vested by the Constitution in the national Government? Must the impediments to the free exercise of the statutory copyright be held to limit the exploitation of the common law copyright to the same degree?"

Judge Gurfein, at page 1192 of the opinion posed these questions and stated further: :A statutory construction that avoids a constitutional problem is desireable."

POINT I

THE 1909 ACT MUST BE INTERPRETED IN LIGHT OF THE TECHNOLOGY EXISTANT THEN AND NOW.

Under an authorization by Congress, the Copyright Office of the Library of Congress has undertaken a program of studies looking to a general revision of the copyright law (Title 17 of the United States Code). Study No. 7, titled PROTECTION OF UNPUBLISHED WORKS, a study prepared for the United States Copyright Office by William Strauss, Attorney-Advisor, Copyright Office, 1958 states at page 48.

"Before the twentieth century, the dichotomy of common law rights for unpublished works and statutory protection for published works created few problems comparable to those of today: the general method of commercial explotiation then was through the publication of printed copies, and the performance of unpublished works could usually be controlled through possession of the manuscripts. Even during the discussions and hearings preceding the Act of 1909 there was no thought that phonograph records, for example, would outstrip printed copies as a medium of communicating and disseminating musical works to the public. Sound motion pictures and broadcasting as a means of public communication were unknown. Also unknown were the modern devices for capturing and reproducing visual and acoustic performances."

"The reason that in 1909 unpublished lectures, musical and dramatic compositions, works of art, and photographs (followed in 1912 by motion pictures) were brought under the statute, was the fact that these classes of copyrightable works were often publicly performed or exhibited without, or before, being published in the form of copies."

"The drafters of the 1909 Act therefore thought of an unpublished work in terms of a work capable of and "intended for oral delivery before it is printed in a book or periodical" and proposed that such a work "might be registered and protected for oral delivery before publication." BOWKER, COPYRIGHT, ITS HISTORY AND ITS LAW (1912).

The developments since 1909 in the field of visual and acoustic mass communication, such as motion pictures, sound recordings, radio and television broadcasts, have made unpublished works accesible to audiences of millions. At the same time the development of devices for the quick and easy recording of sounds and images, by which works performed can be captured and readily reproduced without the manuscript or other copy, have destroyed the possibility of controlling the use of unpublished works through possession of the manuscripts.

In the light of these developments several features of the present law concerning works which, though not "published," are widely disseminated, may be thought to have become outmoded. For one, unless the owner of the common law rights chooses to register the work, he may disseminate the work publicly in every conceivable way except by publishing copies, and his rights continue perpetually in spite of the constitutional policy of copyright for a limited time. This fact may have been the impelling motivation for the recent pronouncements by some courts that the sale of phonograph records is such a publication of the work recorded as to terminate common law rights."

POINT II

THE COMPOSITIONS WERE "PUBLISHED"

Long before the advent of the phonograph record DRONE in THE LAW OF PROPERTY IN INTELLECTUAL PRODUCTIONS 8 (1879), a noted text writer spoke of publication in its broadest sense, on page 115, as follows:

> "Properly speaking, a work is published when it is communicated to the general public. Literary, dramatic, and musical compositions may be published by being read, represented, or performed, or by the circulation of printed or manuscript copies. Paintings, works of sculpture, and similar productions, are published, when publicly exhibited. In short, to publish a thing is to make it public by any means or in any manner of which it is capable of being communicated to the public."

In a logical and practical sense, communication to the public in any manner might be considered an abandonment of control over the property and hence a "dedication of the work to the public" Wheaton v. Peters,8 Pet. 491 (1834).

However, because the copyright law originally protected only books and other printed works, the concept of publication under the statute has generally been confined to the distribution of visual copies of the work, excluding other modes of dissemination such as the distribution of sound recordings. As noted in Appellant's Brief, there has been a recent trend in court decisions toward the view that wide dissemination of a work, particularly through the distribution of sound recordings, is publication terminating common law rights, even though such dissemination cannot be the occasion for securing statutory copyright.

"The courts in most instances have not been persuaded by the argument that no publication occurs by virtue of the sale of a phonograph record because the record is not a "copy" of the work recorded. On the contrary, the relatively few courts which have considered the question have almost unanimously determined that public sale or other distribution of phonograph records does constitute a publication and hence a divestment of common law rights in the works recorded. This conclusion is certainly consistent with the common understanding of the term "copy." Moreover, it is in accord with the underlying rationale of the publication doctrine. That is, an author in permitting records of his work to be publicly marketed is certainly engaging in a form of explotiation of his work and should therefore be required to seek protection, it at all, only under the limited monopoly concept of the federal Copyright Act." NIMMER ON COPYRIGHT, Vol. 1, page 198.

It is interesting to note that in GOLDSTEIN V. CALIFORNIA, 412 U.S. at pg. 565, the Court, after noting that in WHITE-SMITH MUSIC PUBLISHING CO. v. APOLLO CO., 209 U.S. 1, it was held that piano rolls as well as records, were not "copies" of the copyrighted composition, Chief Justice Burger's opinion stated:

> "After pointedly waiting for the Court's decision in WHITE-SMITH MUSIC PUBLISHING CO., congress determined that the copyright statutes should be amended to insure that composers of original musical works received adequate protection to encourage further artistic and crea ive effort. Henceforth, under Sec. 1 (e), records and piano rolls were to be considered as "copies" of the original composition....."

The above is in direct contradiction to Judge Gurfein's opinion in the instant case.

POINT III

THE STATES, MAY NOT, BY VIRTUE OF THE COMMON LAW, CONSTITUTIONALLY IMPOSE A LESSER REQUIREMENT WHEN COPYRIGHT HAS BEEN VESTED BY THE CONSTITUTION IN THE NATIONAL GOVERNMENT.

Having erroneously ruled that a phonograph record is not a "copy" of a musical composition and there is no "publication" divesting the composer of his common law right when the phonograph records are distributed, Judge Gurfein further held that failure to file notice of use precludes the owner from recovering for infringement until statutory copyright is obtained and notice of use is filed.

Plaintiff seeks reversal of the second half of this decision in order to recover for common law copyright infringement, citing GOLDSTEIN V. CALIFORNIA, which upheld the constitutionality of a California anti-piracy statute.

There was a strong dissenting opinion in that case by Mr. Justice Douglas, with whom Mr. Justice Brennan and Mr. Justice Blackmun concurred. Mr. Justice Marshall filed another dissent. The dissenting opinions state that the majority opinion is violative of Article I, cl. 8 of the Constitution, in contradiction of SEARS ROEBUCK & CO. v. STIFFEL CO., 376 U.S. 225, and COMPCO CORP. v. DAY-BRITE LIGHTING, 376 U.S. 234, and that State laws cannot be violative of the Federal Supremacy clause, to all of which the defendant-appellant concurs.

POINT IV

DEFENDANT-APPELLANT SHOULD NOT BE LIABLE FOR TREBLE DAMAGES NOR FOR ATTORNEY'S FEES.

> "The familiar tools of statutory construction, of precedent and its ratio decidendi, of the weight to be accorded stare decisis and of the vaguer notions of public interest in the face of claims to monopolize, all come into play. On the one hand there is distaste for the perpetual monopoly that sustaining common law rights unlimited in time involves. On the other, there is a strong reaction that precedent should be reliable rather than a trap for the unwary, particularly in a technical field where the lawyers, assumed to be learned, guide the hand of the untutored artist. ROSETTE v RAINBO at pg. 1189.

Until the instant decision, there was little probability that defendant or his attorney could have forecast this change in the law. Defendant should not be punished unduly by having to pay treble damages and plaintiff's attorneys' fees.

CONCLUSION

The judgment should be reversed.

RESPECTFULLY SUBMITTED:

WALTER HOFER, ESQ.

OF COUNSEL:

MILTON I. ROTHMAN

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UNITED STATES COURT OF APPEALS
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- *against* -

~~XXXX~~ RAINBO RECORD MANUFACTURING CORP., et al.,

Defendants-Appellants.

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Affidavit of Personal Service

STATE OF NEW YORK, COUNTY OF NEW YORK *ss.:*

I, James A. Steele *being duly sworn, depose and say that deponent is not a party to the action, is over 18 years of age and resides at* 310 W. 146th St., New York, N.Y.

That on the 15th *day of* October *19*75 *at* 270 Madison Ave, N.Y., N.Y.

deponent served the annexed Reply Brief *upon* Zissu Marcus Stein & Couture

the Attorney *in this action by delivering a true copy thereof to said individual personally. Deponent knew the person so served to be the person mentioned and described in said papers as the* *herein,*

Sworn to before me, this 15th *day of* October *19* 75

Robert T. Brin

James A. Steele
JAMES A. STEELE

ROBERT T. BRIN
NOTARY PUBLIC, State of New York
No. 31-0418950
Qualified in New York County
Commission Expires March 30, 1977